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			3622	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,518

Applicant(s)

MATSUKAWA, YUKIHIRO

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-8 have been examined.

Response to Amendment

2. The Amendment filed on 1/14/05 is sufficient to overcome the Hunter reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (6,748,397).

Claims 1-6, 8: Choi discloses that an advertisement is combined with content such that the advertisement cannot be separated from the advertisement by the user:

“(3) The present invention relates to a file structure for preventing edition and deletion in the Internet, a variety of computers and computer application media, an advertising method using this file structure and a system used for this advertising method. More particularly, the invention relates to a file structure for preventing edition and deletion in the Internet, a variety of computers and computer application media, an advertising method using this file structure and a system adapted for this method, which is capable of providing various information items such as music, music video, movies, games and programs together with advertisements free to

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users through the Internet, a superfast communication network, a dedicated line network, or a general communication networks, and preventing an information file provided to the users from being reproduced if the information, advertisement, and/or header is edited or deleted” (col 1, lines 11-30).

Choi discloses downloading or transmitting the combined content and advertising:

“(13) The manager of the web server determines the type of advertisement or the number of advertising times on the basis of the sex, age and area of the user or the object the sponsor wants. In the second step, an advertisement file selected by the user who wants to download music, music video, movie, game or program is read from the advertisement database to be combined with the information file. The information file combined with the advertisement is delivered to the user from the web server via a communication means, such as Internet, dedicated line network, superfast communication network and general communication network” (col 3, lines 10-22).

Choi discloses multiple types of advertising and that the advertising can be placed at different points relative to the content:

“(14) Further, the advertisement combined with the information file is at least one of a sound advertisement, a banner advertisement and a moving picture advertisement. The sound advertisement is selectively outputted at the beginning time and/or finishing time of music, music video, movie, game or program. The banner is displayed on a predetermined position of a screen at the beginning time and finishing time of the music, music video, movie, game or program and during reproduction thereof. The moving picture advertisement is displayed on a

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predetermined position of a screen at the beginning time and finishing time of the music, music video, movie, game or program and during reproduction thereof" (col 3, lines 30-44).

Choi discloses a downloadable algorithm for separating the advertising from the content that runs after the user has played the content a predetermined number of times:

"(18) Preferably, the user is authenticated by the web server for access thereto to receive an algorithm for separating the music file and moving picture advertisement file from each other from the web server and installs it before installation or reproduction of the music file combined with the moving picture advertisement file transmitted from the web server at the user side. When the user requests the web server to authenticate him for separating the music file from the moving picture advertisement file, the web server searches information of the log database of the information database to judge standards, such as the period of time during which the music file with which a predetermined advertisement is combined is generated and maintained and the number of listening times of the user, are satisfied and, when they are satisfied, delivers the algorithm for separating the music file and moving picture advertisement file from each other to the user (col 4, lines 31-47);

(26) Meanwhile, the user 10 can be authenticated to connect with the web server 3 and then download an algorithm for separating the music file from the moving picture advertisement file from the web server 3 before installation or reproduction of the moving picture advertisement file and music file transmitted from the web server 3 at the user side. Specifically, when the user 10 requests the web server 3 for authentication in order to separate the music file and moving picture advertisement file from each other, the web server 3 searches a log database of the information database 1 to judge if a period of time during which a music

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file combined with a predetermined advertisement is generated and maintained or the number of music file listening times of the user is satisfied. When it is, the web server 3 delivers the algorithm for separation of the music file and moving picture advertisement file from each other to the user 10. Here, the log database of the information database 1 stores log information configured of at least one of information about the position of the moving picture advertisement file in the music file, information about the number of music file listening times of the user, information about the user who requests the music file, information about the copyright of the music file, and information about the music file and moving picture advertisement file combined therewith.

(27) After authentication by the web server 3, the user 10 can separate the music file from the moving picture advertisement file. Furthermore, the user 10 can combine an advertisement audio file with the music file from which the moving picture advertisement file was separated and transmit the combined file to the web server 3 to store it therein. Here, the user 10 judges the forms of the music file from which the moving picture advertisement file was separated and the advertisement audio file and converts them into predetermined forms (FMG, FPG) to deliver them to the web server 3. Especially, the number of times of reading a music file from the music file database to transmit it to the user 10 and the number of times of reading a moving picture advertisement file of a specific sponsor from the moving picture advertisement database to transmit it to the user are respectively counted such that the royalty with respect to the music file and the advertising rate for the advertisement file can be calculated on the basis of the number of times of transmission the music file and moving picture advertisement file. In addition, the musical taste of the user can be grasped (col 11, lines 3-47);

[Claim] 18. The advertising method as claimed in claim 14, wherein the user is authenticated by the web server for access thereto to receive an algorithm for separating the music file and moving picture advertisement file from each other from the web server and installs it before installation or reproduction of the music file combined with the moving picture advertisement file transmitted from the web server at the user side.

[Claim] 19. The advertising method as claimed in claim 14, wherein, when the user requests the web server to authenticate him for separating the music file from the moving picture advertisement file, the web server searches information of the log database of the information database to judge standards, such as the period of time during which the music file with which a predetermined advertisement is combined is generated and maintained and the number of listening times of the user, are satisfied and, when they are satisfied, delivers the algorithm for separating the music file and moving picture advertisement file from each other to the user" (col 14, lines 7-27).

Choi discloses that a variety of user related information can be transmitted:

"(21) In this advertising method, preferably, the header of the combined file of the music file and moving picture advertisement file includes information about the position of the moving picture advertisement in the music file, information about the number of listening times of the user, information about the user, information about the copyright of the music file, information about the music file and moving picture advertisement file combined therewith and link information about sponsors such that the user can instantly connect with a web server of corresponding sponsor if he wants when the music file combined with which the moving picture advertisement is reproduced. The number of times of reading each music file

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from the music file database and transmitting it and the number of times of reading a moving picture advertisement file of a specific sponsor from the moving picture advertisement database and transmitting it are respectively counted, and the royalty with respect to each music file and the advertising charge with respect to each advertisement are calculated on the basis of the number of times of transmitting the music file and the number of times of transmitting the moving picture advertisement file” (col 4, line 65-col 5, line 20).

Choi discloses prevent deletion in advance of the advertising and different content types:

“(28) As described above, the present invention converts the structure of a file such as music, movies, music videos, games and programs, currently distributed with charges on the Internet and computer application media. That is, the invention provides a new program technique which combines an advertisement with a file and provides it to users free. Accordingly, the present invention can not only provide information such as music, movies, music videos, games and programs to the users via the Internet, dedicated line network, super fast communication network or general communication network but also prevent the information file, advertisement file and header provided to the users from being edited or deleted in advance” (col 11, lines 47-61).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Choi’s algorithm downloaded to the user machine and then run from the user machine can be an executable . One would have been motivated to do this because an exe is a standard way of transmitting or utilizing an algorithm file.

Choi does not explicitly disclose that the separation of the advertising from the content after a predetermined number of play times is automatic.

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However, Choi further discloses automatically separating or deleting advertising from content :

“The advertisement file which was combined with the information file is automatically deleted when the newly requested advertisement file replaces it (col 9, lines 10-15).

The new moving picture advertisement file is processed by the web server 3, with the existing one being automatically deleted, to be delivered to the user 10 through the Internet” (col 10, lines 55-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Choi’s automatic deletion or separation of the advertising from the content can be added to the user being enabled to separate the advertising from the content after a predetermined number of plays. One would have been motivated to do this in order to make the system more user convenient.

In regards to claim 3, Chois further discloses that the advertising can be played at the beginning and/or finishing time of the content:

“Further, the advertisement combined with the information file is at least one of a sound advertisement, a banner advertisement and a moving picture advertisement. The sound advertisement is selectively outputted at the beginning time and/or finishing time of music, music video, movie, game or program. The banner is displayed on a predetermined position of a screen at the beginning time and finishing time of the music, music video, movie, game or program and during reproduction thereof. The moving picture advertisement is displayed on a predetermined position of a screen at the beginning time and finishing time of the music, music video, movie, game or program and during reproduction thereof. The banner is displayed on a

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predetermined position of a screen at the beginning time and finishing time of the music, music video, movie, game or program and during reproduction thereof. The moving picture advertisement is displayed on a predetermined position of a screen at the beginning time and finishing time of the music, music video, movie, game or program and during reproduction thereof" (col 3, lines 30-45).

The online Merriam-Webster dictionary at www.m-w.com defines 'time' as:

"1 a : the measured or measurable period during which an action, process, or condition exists or continues : **DURATION** . . .

3 a : an appointed, fixed, or customary moment or hour for something to happen, begin, or end".

Since the advertising can be at the time of beginning or finishing of the content and since the time of beginning or finishing can be interpreted as a limited period or as a moment, it is obvious that advertising can overlap with the beginning or finishing of the content playing.

In regards to claim 8, Choi further discloses that the positional information or area of said user terminal is known (Fig. 1, item 1 and 10) and:

"The manager of the web server determines the type of advertisement or the number of advertising times on the basis of the sex, age and area of the user or the object the sponsor wants (col 3, lines 10-15).

[Claim 3]. The advertising method as claimed in claim 2, wherein the manager of the web server determines the type of advertisement or the number of advertising times on the basis of the sex, age and area of the user or the object the sponsor wants" (col 12, lines 35-40).

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4. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (6,748,397) in view of Ansell (6,367,019).

Claim 6: Choi discloses the system above.

Choi further discloses the utilization of passwords to access the content (Fig. 3; Fig. 4).

Choi further discloses authorizing user actions involving the content and advertisement use (col 4, lines 15-20; col 14, lines 17-27).

Choi does not explicitly disclose that if the content is transferred that it cannot be played unless a password is utilized.

However, Ansell discloses that if the content is transferred that it cannot be played unless a password is utilized.

Ansell discloses making content unplayable when content is copied or transferred from one user terminal to another user terminal unless a password is utilized (col 5, lines 39-46; col 8, lines 19-45; Fig. 6, Fig. 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ansell's making the content unplayable without a password to Choi's authorizing a user to access content and to separate content from advertising. One would have been motivated to do this in order to control or authorize the transfer of content without advertising.

Response to Arguments

5. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

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Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Hendricks (6,738,978) discloses combining advertising and content information in downloads.

b. Picco (6,029,045) discloses combining advertising and content information in downloads.

b. Virine (6,671,736) discloses combining advertising and content information in downloads.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

3/4/05


JEFFREY D. CARLSON
PRIMARY EXAMINER